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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

LAUFER, P

ART UNIT

PAPER NUMBER

2766

31

DATE MAILED:

06/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/895,493

Applicant(s)
Makoto Saito

Examiner
Pinchus M. Laufer

Group Art Unit
2766



☒ Responsive to communication(s) filed on 3 Apr 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 95-142 is/are pending in the application.

Of the above, claim(s) the claims listed in paragraph 4 as previously non-elected are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) All examined claims is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 95-142 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Docketing

2. Please note that the application has been redocketed to a different examiner. Please refer all future communications regarding this application to the examiner of record, using the information supplied in the final section of the office action.

Continued Prosecution Application

3. The request filed on 3 April 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/895,493 is acceptable and a CPA has been established. An action on the CPA follows.

Information Regarding the Election/Restriction Requirement

4. The current Application is a CPA of the parent application wherein an election requirement was maintained. In the parent application, a provisional election was made, *without traverse*, to prosecute the invention of Species I. Subsequently examination was carried out on generic claims along with the elected Species I. Applicants confirmed the election of Species I in their response to a USPTO office action on 7-17-1997.

The CPA application does not indicate that a change in election is desired. The election in the parent application therefore is carried into the CPA. See, M.P.E.P. § 819.

Claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140 are, therefore, withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected species.

5. This application contains claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140, which are drawn to an invention nonelected without traverse in Paper No. 18. **Applicant is reminded** that a complete reply to the final rejection (Paper No. 26) **must** include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Substitute Specification

6. Applicant seems to believe that the substitute specification merely needs to "incorporate the amendments" previously submitted. This is not the case. See the statement of the requirement in the previous action.
7. The Examiner acknowledges Applicant's desire to defer preparing a substitute specification until such time as Allowable Subject matter has been identified. The Examiner has no problem with this in principle. However, Applicant should be aware that deferring such a submission may result in delayed issuance of the patent owing to the new expedited procedures for issuing patents.

Double Patenting

8. The Examiner acknowledges the filing of a terminal disclaimer (Paper No. 27, filed 3 April 2000) with respect to U.S. Patent No. 5,646,999. This disclaimer removes the non-statutory double patenting rejections of record in the previous Office communications.

Claim Rejections - 35 U.S.C. § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125, and 126 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 95 and 111 each recite "said utilization permit key being at least one of ..." and then proceed to recite a string of operations using each of the keys enumerated in the list. Since the claim does not recite supplying **all** of the keys in the list it is not clear how the functions can be performed.

Observation with Respect to Claim Language

11. With respect to claims 95, 111, and the claims depending from them, the various recitation of keys are read to include the scope of the utilization permit key being the crypt key which comprises a display permit key, since the language states "at least one utilization permit key including a crypt key". With respect to claim 127, note that there is only a single key recited and that optional steps are still recited.

Claim Rejections - 35 U.S.C. § 102 & 103

12. Claims 95, 97, 99, 101, 103, 104, 127, 129, 131, 133, 135 and 136 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dolphin ('746).

With respect to the independent claim 95, Dolphin teaches a database (21 in Fig. 1) supplying encrypted data (22 in Fig. 1) to a user 26 in Fig. 1); in response to the user's request (27' of Fig. 2) a key control center (23 of Figs. 1 and 2) supplies a crypt key to the user (27" in Fig. 2); the user displays the data after decryption by the decrypt key (see, e.g., 54-58 of column 6; note that user 26 has a computer 31 which includes a monitor to display the data--which "can include, for example, video, image, photographs, databases, sound, [and] software," see, lines 17-18 of column 5). The decryption is under a copyright control program (the decryption algorithm in the PCMCIA card 29 and on the CD 70D and 70E of Fig. 10).

With respect to claim 97, Dolphin teaches supplying copyright control program (elements 70D, 70E in Fig. 10) by the database (publisher 21 of Fig. 1). With respect to claim 99, Dolphin teaches copyright control program using copyright information (see, e.g., line 48 of column 12 to line 48 of column 13; see especially lines 45-47 of column 13 explaining that the counter updating the encryption information--anticipating copyright information because it updates and enables access to new copyrighted data--of the new data is provided as part of the CD-ROM). With respect to claim 103, Dolphin teaches entering the copyright information into the data being sent (see, e.g., lines 45-47 of column 13).

With respect to claim 104, Examiner notes the further recitation of "copyright information is entered as a computer virus" is treated as intended outcome of a broadly scoped limitation of entering the copyright information; as such Examiner notes that in Dolphin, providing the copyright information is by associating it with the other data which is within the scope of entering the copyright information as a computer virus because a the copyright information is associated with data as a computer virus may be associates with data.

Applicant argues that Dolphin does not teach a permit key which gives permission for a specific function, and therefore Dolphin does not copying with a copy key etc.

In response, see column 5 lines 54 through column 6 line 10. Dolphin discloses the key being used to permit limited number of viewings of a file, or a copy or a print as examples. These are specific functions.

Applicant argues with respect to claim(s 111 and) 127 that Dolphin does not teach re-encrypting prior to storing, copying or transferring the data.

In response, This limitation is not positively recited in claim 127.

13. Claims 105, 107, 109, 110, 137, 139, 141, and 142 are rejected under 35 U.S.C. § 103 as being unpatentable over Dolphin in view of Daniele ('771). Daniele [see for example, 8:56-9:25] teaches modifying the copyright control glyph to indicate the status and history of the document for auditing and tracking of royalty information and accounting. In light of this teaching, one of ordinary skill in the art would be motivated to include similar auditing information in a copyright control system to allow for proper apportionment of royalties.

14. Claims 111, 113, 115, 117, 119, and 120 are rejected under 35 U.S.C. § 103 as being unpatentable over Dolphin. Claim 111 (as compared to claim 95) includes the additional limitation of reencrypting the data before storing, copying, or transferring it. It is well known to not allow the storage of controlled (digital) information in an uncontrolled manner because then a single copy can be used to make myriad perfect copies thus destroying the security and/or economic value of the original. Since Dolphin is directed to protecting the commercial interest of the publisher, it would have been obvious to one of ordinary skill in the art to require reencryption prior to transfer to any further media such as by copying, storing, or transmitting.

15. Claims 121, 123, 125, and 126 are rejected under 35 U.S.C. § 103 as being unpatentable over Dolphin as applied to claim 115 above, and further in view of Daniele ('771). Daniele [see for example, 8:56-9:25] teaches modifying the copyright control glyph to indicate the status and history of the document for auditing and tracking of royalty information and accounting. In light of this teaching, one of ordinary skill in the art would be motivated to include similar auditing information in a copyright control system to allow for proper apportionment of royalties.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sasamoto et al. ('969) shows that data is only stored in re-encrypted form and Morishita et al. ('175) discloses a software copyright management system

Response to Arguments

17. Applicant's arguments filed 3 April 2000 have been fully considered. See the responses following the relevant rejections above. Note also, that new rejections have been entered because of the amendments to the claims.

Information Regarding Communication with the PTO

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 8:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

June 26, 2000

Pinchus M. Laufer
Pinchus M. Laufer
Primary Examiner
Art Unit 2766